

REMARKS

The Examiner has rejected Claims 4-6 under 35 U.S.C. 102(b) as being anticipated by Britton (U.S. 1,590,227). This rejection is respectfully traversed. Applicant's Claims 4-6 have been amended to include a combination dinner plate and clip-on device. Britton describes a support for a nursing bottle attached to a baby carriage or crib. The clip 10 of Britton is not a c-ring adapted to grip an edge of a tableware plate. Rather, it is a u-shaped clip sized to grip a rail of a carriage. Therefore, the clip 10 is not adapted to grip an edge of a tableware plate as set forth in applicant's Claims 4-6. Furthermore, the Britton clip is not integral with a rearwardly extending shaft with a distal end of the shaft connected to a ball. Rather, Britton shows a clip integral with a socket 14 which contains a shaft 16. The shaft 16 connects to a ball 17. The ball 17 is not supported by an axially mounted pin attached to the distal end of the shaft as set forth in applicant's Claims 4-6. Still further, Britton fails to show a means for gripping the ball being a frictionally engaging partial circular member as set forth in applicant's Claim 5, nor a clamping device mounted on the shaft for displaying an ornament as in applicant's Claim 6.

Before a reference can be properly used as a 35 U.S.C. 102(b) reference, it must describe every feature of applicant's

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claimed invention. Britton certainly does not describe every feature of applicant's invention as shown above. For this reason, the rejection of Claims 4-6 based on 35 U.S.C. 102(b) should be withdrawn.

The Examiner rejected Claim 1 under 35 U.S.C. 103(a) as being unpatentable over Barnes in view of The Sugiuna Japanese patent. This rejection is respectfully traversed. Barnes describes a lamp bracket and Sugiuna merely describes a ball joint. The Barnes device includes an arm composed of a single length of wire having an end bent to constitute an engaging hook. A portion of the arm has an engaged split socket. A pair of spring arms hold the socket of a light bulb. The Examiner admits that Barnes fails to teach a c-ring which is critical for applicant's device to grip a piece of tableware. Further, the Examiner admits that Barnes fails to teach a ball supported by an axially mounted pin attached to the shaft at a point distal from the c-ring. The Examiner suggests that the Sugiuna reference would modify Barnes to create applicant's device. Nothing is further from the truth.

The test for obviousness is what the combined teaching of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the Examiner to

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provide a reason why one of ordinary skill in the art would have been led to modify a prior reference or to combine reference teachings to arrive at the claimed invention. See, Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Applying this guidance to the situation at hand leads one to conclude that this rejection of Claim 1 cannot be sustained. By adding a ball joint from Sugiuna to the Barnes lamp bracket and considering them together, they do not produce a c-ring adapted to grip an edge of tableware with a ball supported by an axially mounted pin attached to a shaft at a point distal from the c-ring, and a circular cap supporting a T-bar supporting spreadable lips adapted to hold an ornament.

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Applicant fails to perceive any teaching, suggestion or

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incentive which would have led one of ordinary skill in the art to add to the Barnes device a ball supported by an axially mounted pin attached to a shaft, other than the hindsight afforded one who first viewed the applicant's disclosure, which cannot form the basis for a rejection under Section 103. In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). This problem is not alleviated by consideration of the teachings of Barnes and Sugiuna within the meaning of 35 U.S.C. 103(a). Therefore, this rejection should be withdrawn.

The Examiner rejected Claim 3 under 35 U.S.C. 103(a). This rejection is traversed. Claim 3 is dependent from Claim 1 and contains all the elements of Claim 1 plus the added feature that the tableware clip-on device is molded from a high strength polymer. The rejection is based on Barnes in view of Sugiuna and Vantine. Barnes and Sugiuna have been discussed above in connection with Claim 1. Vantine describes an ear protection device made from polypropylene. There is no suggestion that Vantine's polypropylene would be appropriate for the devices in either Barnes or Sugiuna. Certainly, there is no suggestion among these three references that one or more of their elements could be used to create applicant's polymeric tableware clip-on device of Claim 3. Taking all three references together and considering them as a whole, they do not make applicant's device of Claim 3 obvious within the

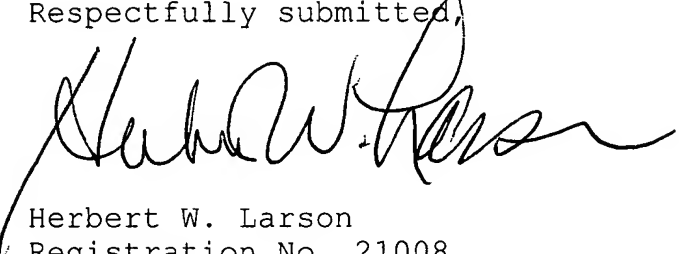
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meaning of 35 U.S.C. 103(a). Therefore, this rejection should be withdrawn.

In view of all the above, it is believed that Claims 1 and 3-6 are now in condition for allowance. Such action is earnestly solicited.

Respectfully submitted,



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